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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,708	03/04/2004	Minoru Hanatani	KATA-189	5092
217 7590 03/27/2008 FISHER, CHRISTEN & SABOL 1725 K STREET, N.W. SUITE 1108 WASHINGTON, DC 20006				
EXAMINER MAYEKAR, KISHOR				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
03/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/791,708

**Applicant(s)**

HANATANI ET AL.

**Examiner**

Kishor Mayekar

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 100)  
Paper No(s)/Mail Date 4/12/04 & 4/27/04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of invention of Group I, claims 1-4 and 6-8, species epoxy compound (a<sub>3</sub>) of the polyhydric polyol in the reply filed on 12 February 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an **amine-added epoxy resin (A)** obtained by **reacting** an epoxy resin (a<sub>1</sub>) with an epoxy compound (a<sub>3</sub>) of a polyhydric polyol to form a modified epoxy resin and then by **reacting** the modified epoxy resin with an amino group-containing compound (a<sub>6</sub>), does not reasonably provide enablement for the amine-added

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epoxy resin (A) obtained by reacting an epoxy resin ( $a_1$ ) with an epoxy compound ( $a_3$ ) of a polyhydric polyol. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The above claims recite that an amine-added epoxy resin (A) is obtained by reacting an epoxy resin ( $a_1$ ) with one or more modifying agent(s) where one of the modifying agents (the elected species) is an epoxy compound ( $a_3$ ) of a polyhydric polyol. Because of the breadth of the claims, the above claimed subject matter can be interpreted as that the amine-added epoxy resin (A) is obtained by the reaction of the epoxy resin ( $a_1$ ) with the epoxy compound ( $a_3$ ) of the polyhydric polyol, for example. And the specification does not enabling such an interpretation. The specification clearly discloses in the first full paragraph of page 13 that "the amino group-containing compound ( $a_6$ ) is added to the modified epoxy resin to obtain an amine-added epoxy resin (A)", and in paragraph crossing pages 12 and 13 that the modified epoxy resin is obtained by reacting the epoxy resin ( $a_1$ ) with one or more of the modifying agents where one of the modifying agents (the elected species) is an epoxy compound ( $a_3$ ) of a polyhydric polyol.

4. Claims 1-3 and 6 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the coating of the cationic electrodeposition coating composition by an electrodeposition coating (third full paragraph in page 19), does not

reasonably provide enablement for the coating of the cationic electrodeposition coating composition by any other coating technique, such as by coil coating. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The above claims recite that the method comprises coating of the cationic electrodeposition coating composition onto the substrate. Because of the breadth of the claims, the above claimed subject matter can be interpreted as that the cationic electrodeposition coating composition can be coated by coil coating, for example. And the specification does not enabling such an interpretation.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite and confusing since the claim recites the reaction of an epoxy resin ( $a_1$ ) with one or more modifying agents where one of the modifying agents (the elected species) is an epoxy compound ( $a_3$ ) of a polyhydric polyol to form an amine-added

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epoxy resin. It is not clear how the formed amine-added epoxy resin contains the added amine when the recited reaction is from the non-amine-containing modifying agent.

Depending claims 2-4 and 6-8 are indefinite for their dependence upon an indefinite claim 1.

Further, in claim 4, the recitation "after starting of energizing" is either confusing as whether it is another step of claim 1 or is lacking antecedent basis.

In claim 7, the same is applied to claim 4.

In claim 8, the same is applied to claim 4.

*Allowable Subject Matter*

7. Claims 1-4 and 6-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter: Because the prior art references do not disclose in a coating film-forming method the step of electrodeposition coating a cationic electrodeposition coating composition onto a substrate followed by heat curing to form a cured electrodeposition coating film, where the cationic electrodeposition coating composition containing the recited curing agent and a base resin consisting of an amine-added epoxy resin (A) obtained by reacting an epoxy resin ( $a_1$ ) with an epoxy compound ( $a_3$ ) of a polyhydric polyol to form a modified

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epoxy resin, and then by reacting the modified epoxy resin with an amino group containing compound (a<sub>6</sub>).

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kishor Mayekar/  
Primary Examiner, Art Unit 1795

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